

**REMARKS**

The present application includes claims 1-7. Claims 1 and 2 were rejected by the Office Action under 35 U.S.C. § 102(b). Claims 3-7 were rejected under 35 U.S.C. § 103(a). By this Amendment, claims 1, 3, and 7 have been amended. Notably, claim 7 has been amended to correct a inadvertent punctuation mistake, namely to include a period at the end of the claim.

**I. INFORMATION DISCLOSURE STATEMENT**

The Office Action states that the listing of the references in the Patent Cooperation Treaty is not a proper information disclosure statement.

On August 24, 2007, pursuant to 37 C.F.R. § 1.56, Applicant electronically filed a Information Disclosure Statement that lists references that are included in the International Search Report for PCT/GB2004/001377. At the time of the IDS filing, a the present Office Action had already been mailed to the Applicants. Reference EP 0109242A2, which is listed in the International Search Report, was not included in the Information Disclosure Statement submitted by the Applicant, as that reference had already been cited by the Examiner in the present Office Action as a basis for the 35 U.S.C. §§ 102(b) and 103(a) rejections of the pending claims.

**II. Specification**

The Office Action requires that the Applicants amend the title of the invention. Accordingly, with this Response, the Applicants have amended the specification, and the title now reads: System And Method For Providing Image Forming Composition On A Substrate.

Applicants have also amended the specification to correct typographical errors and make minor grammatical corrections. More specifically:

- Paragraph [0006] has been amended to insert a period between the words “level” and “Furthermore”;
- Paragraph [0008] has been amended to insert a period at the end of the paragraph;
- Paragraph [0014] has been amended to correct the capitalization of “The” and “Varibale” and to correct minor grammatical errors;
- Paragraph [0021] has been amended to correct the capitalization of “This”; and
- Paragraph [0068] has been amended to correct a typographical error regarding the word “valve”.

### **III. REJECTIONS UNDER 35 U.S.C. § 103(A)**

Claims 3-7 were rejected under 35 U.S.C. § 103(a) as purportedly being obvious over EP 0109242 A2 (Taylor et al.) in view of WO 03/069201A1 (Horsnell et al. application).

#### **A. Horsnell et al. Does Not Qualify As Prior Art**

The Applicants respectfully submit that the cited Horsnell et al. application does not qualify as prior art with respect to the present application. The cited Horsnell et al. application has an international publication date of August 21, 2003. However, the present application has a PCT filing date of March 25, 2004 (with the PCT application designating the US), and claims a foreign priority date of March 25, 2003 - five months before the international publication date of the cited Horsnell et al. application. Further, both the cited Horsnell et al. application and the present application share all the same inventors. Additionally, the Applicants respectfully submit

that the present application and the cited Horsnell et al. application were, at the time the invention of the present application was made, both owned by Willett International Limited.

Accordingly, Horsnell et al. is not prior art under § 102(a), as it does not satisfy the “by others” requirement and its international publication date is five months after the claimed foreign priority date of the present invention. Horsnell et al. is also not prior art under § 102(b), as the cited Horsnell et al. reference was published less than one year before the PCT filing date of the present application. Horsnell et al. also does not satisfy the “by others” requirements to be prior art under § 102(e). And even if it the cited Horsnell et al. reference did qualify as prior art under § 102(e), which it does not, that reference would be disqualified under § 103(c). The Applicants also respectfully submits that the cited Horsnell et al. reference also does not qualify as prior art under any other subsections of § 102.

Accordingly, at least for these reasons, the combination of the cited Horsnell et al. application and Taylor et al. does not render claims 3-7 of the present application unpatentable.

**B. REJECTIONS UNDER 35 U.S.C. § 102(b)**

Claims 1 and 2 were rejected under 35 U.S.C. § 102(b) as purportedly being anticipated by Taylor et al.

The Office Action asserts that Taylor et al. does not disclose a solenoid valve having a diameter of less than 2.5 mm. Accordingly, based on this assertion, and in view of the cited Horsnell et. al. application not qualifying as prior art, the Applicants have amended claim 1 to include the feature “the drop on demand ink jet printer comprises an array of nozzles, at least one

Application No. 10/550,807  
Attorney Docket No. 16970US01

solenoid valve to, in use, control the flow of the image forming composition through the nozzle orifices, the plunger of the at least one solenoid valve having a diameter of less than 2.5 mm.”

Accordingly, Applicants respectfully submit that independent claim 1, and the associated dependent claims 2-7, are now in a condition for allowance.

Application No. 10/550,807  
Attorney Docket No. 16970US01

**CONCLUSION**

The Applicants respectfully submit that the claims of the present application are in condition for allowance for at least the reasons discussed above. A Notice of Allowance is therefore requested. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited and encouraged to contact the Applicants at the number below.

The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: November 15, 2007

/s/ William B. Gont  
William B. Gont  
Registration No. 57,232

MCANDREWS, HELD & MALLOY, LTD.  
500 West Madison Street, 34th Floor  
Chicago, IL 60661

Telephone: (312) 775-8000  
Facsimile: (312) 775-8100